

REMARKS

The Applicant respectfully submits this Amendment And Request For Reconsideration in response to the Office Action of 08 November 2010 for the above-referenced patent application.

In the present Amendment, the Applicant amends claims amend claims 1-2, 4, 6-7, 12-13, 15, 17-18, and 32, and 34; no claims have been added or canceled. The Applicant respectfully requests entry of the amendment and reconsideration of the claims 1-2, 4, 6-7, 10, 12-13, 15, 17-18, 20, 21, 32-34 as revised based on the reasons presented herein.

In the Office Action of 08 November 2010, the Examiner rejected claims 1-22 and 32-34 under 35 U.S.C. § 103(a) as being obvious over Jin (U.S. Patent Application Publication No. US2002/0084888A1) in view of Minborg (U.S. Patent No. 6,977,909). In response, the Applicant respectfully disagrees with the Examiner's rejections, especially in light of the present claim amendments, and submits that all pending claims 1-7, 9-22, and 32-34 as revised are allowable over the prior art for at least the following reasons.

In order for claims to be properly rejected under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims.

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Ex Parte Wada and Murphy, Appeal No. 2007-3733, Bd. Pat. App. & Inter., January 14, 2008. Because at least one limitation in each claim is not taught

or suggested by the Examiner's asserted combination of art, the rejection the claims cannot be maintained.

All pending claims 1-2, 4, 6-7, 10, 12-13, 15, 17-18, 20, 21, 32-34 as now revised are directed to techniques involving the "**automatic**" grouping of user-specific information items (specifically, a telephone number and an e-mail address) into a "**draft e-mail message**" which is triggered "in response to detecting a selection of an option to add the user-specific information items" which occurs "**while the draft e-mail message is being displayed.**"

For one, the Applicant respectfully submits that the Jin reference does not pertain to the "automatic" grouping of user specific information items within a **draft e-mail message**, as claimed. Rather, the Jin reference describes the processing of information in a short message service "SMS" message or "short message." Rather, the Jin reference processes information in relation to a short message service (SMS) message or "short message." See e.g. paragraph [0032] of Jin, stating "the mobile terminal generates the personal information of the user into a short message and transmits the personal information according to a procedure for SMS." Further, no e-mail message being drafted by a user is being displayed in a display of Jin.

Secondly, the Applicant respectfully submits that the Jin reference also fails to teach or suggest an "automatic" grouping which is performed "in response to detecting a selection of an option to add the user-specific information items" which occurs "**while the draft e-mail message is being displayed.**" Note again that the Jin reference processes information in a short message service (SMS) message or "short message." See e.g. paragraph [0032] of Jin, stating "the mobile terminal generates the personal information of the user into a short message and transmits the personal information according to a procedure for SMS." No e-mail message being

drafted by a user is being displayed in a display of Jin while such triggering occurs.

Thirdly, the Applicant respectfully submits that the Examiner is in error for relying on the Jin reference, as it further fails to teach or suggest the claimed "automatic" grouping of user specific information items in a draft e-mail message, but rather describes a "manual" process for the user/manual entry of data in a special SMS message. As claimed, the specific "automatic" grouping actions include "reading" a telephone number from a first file for a voice call application and "storing" it in the draft e-mail message, and repeating these acts for an e-mail address read from a second file (i.e. "reading" the e-mail address from the second file for a e-mail communication application and "storing" it in the draft e-mail message as well). As claimed, all of these grouping actions are performed "automatically" in response to the detection of the selection of the option. See e.g. pending claim 1 of the application.

Words of a claim must be given their "plain meaning," which refers to the ordinary and customary meaning given to the terms by those of ordinary skill in the art. The ordinary and customary meaning of the term "automatic" is *"acting or operating in a manner essentially independent of external influence or control"* (see the amendment of 16 October 2009 which includes an attachment with the definition of "automatic").

When read in context of the claims, the meaning of the terminology "automatically grouping" which is performed by a "mobile station" or its "processor" means that the claimed automatic grouping actions ("reading," "storing," and repeating) are performed by the mobile station or processor in a manner independent of the user of the mobile station. Put another way, it means that these actions are performed without user or manual intervention. This interpretation is consistent with the "automatic grouping" operation described in the specification. See e.g. FIG. 5 and page 20 at lines 13-16 of the application.

In the rejection of claims, the Examiner alleges that the Jin reference teaches or suggests these claimed limitations. Essentially, the Examiner equates the manual process of Jin, where the user manually enters or selects data via the screen (see FIG. 2, paragraph 30, FIGs. 4a-4f, and paragraphs 40-44 of Jin), with the automatic grouping of user-specific information items as claimed and described. In particular, the Examiner appreciates that in Jin the user must regularly press the "next" button or "enter" on the mobile terminal for the manual entry of data. As apparent, as Jin's process is performed in a manner that is dependent on the user of the mobile station for manual entry/selection of data; however, this is not that which is claimed and is in fact just the opposite.

As apparent, Jin fails to teach or suggest any **automatic** grouping of user-specific information items (i.e. a telephone number and an e-mail address) in a **draft e-mail message**, triggered by "in response to detecting a selection of an option to add the user-specific information items" which occurs "**while the draft e-mail message is being displayed**" as claimed.

Based on these reasons, the Applicant respectfully submits that the claims as revised are allowable over the prior art of record. Other reasons for allowability of both the independent and dependent claims are apparent to those skilled in the art, but are not detailed herein due to the already-indicated reasons for allowability.

Thus, the Applicant respectfully requests the Examiner to withdraw the rejections of pending claims 1-2, 4, 6-7, 10, 12-13, 15-, 17-18, 20-21, and 32-34, as revised. The Applicant submits that the application as amended is in a condition suitable for allowance.

Respectfully submitted,

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